

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

New independent claims 21 and 22 are currently added to the application and recite the allowable subject matter of claims 6 and 7, in combination with the limitations of claim 1 from which they were originally dependent. New dependent claim 23 recites the allowable subject matter of claim 9, and is dependent from new claim 22. Claims 6, 7 and 9 are canceled in view of the new claims.

The new claims were not previously added to the pending application since in the previous office action dated July 24, 2005, the subject matter of claims 6, 7 and 9 was not yet identified as being allowable.

It is respectfully submitted that no new issues requiring further detailed consideration or search have been presented by the proposed amendments and that entry of the claim amendments is appropriate under 37 C.F.R. § 1.116. Entry of the amendment at least for purposes of appeal is respectfully requested in view of the fact that they present rejected claims in better form for consideration on appeal (37 C.F.R. 1.116).

2. Rejection of claims 1-5, 8 and 10-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,719,950 (*Osten*) in view of U.S. patent 6,081,750 (*Hoffberg*)

This rejection is respectfully traversed on the basis that the proposed combination of the teachings of *Osten* and *Hoffberg*, whether considered collectively or individually, fail to disclose all of the recited limitations of these claims, and suggest to one skilled in the art how to devise the method, chip card and system of the

rejected claims. Moreover, even if combined together, the teachings of *Osten* and *Hoffberg* would not result in the claimed method, chip card and system of the claims.

As a result, the proposed combination of *Osten* and *Hoffberg* fails to render the pending claims *prima facie* obvious .

a. *Osten* and *Hoffberg* do not disclose all of the claimed limitations

The proposed combination of *Osten* and *Hoffberg* fails to disclose all of the claimed limitations recited by claims 1-5, 8 and 10-20. The applicants are fully aware that one cannot argue against the references individually, as pointed out by the examiner in the outstanding office action. However, it is axiomatic that in order to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. In the current rejection, both *Osten* and *Hoffberg* collectively fail to teach all of the claimed limitations.

The evidence in *Osten* and *Hoffberg* relied upon by the examiner, as a whole, fails to indicate that it would have been known to one skilled in the art at the time of the invention of the pending application to determine at least one parameter based on at least one individual property of the person that specifically influences sensory detection of biometric data, and to store the determined parameter to be taken into account in a verification step.

When discussing the features of both *Osten* and *Hoffberg*, the current rejection of the claims appears to ignore the limitation “specifically influences.” Instead, the rejection merely indicates that *Osten* and *Hoffberg* teach acquiring biometric parameters that can influence biometric data; such biometric data collection by *Osten* and *Hoffberg* are unrelated to any particular parameter that affects sensory detection of certain biometric data.

It is clear that neither *Osten* nor *Hoffberg* disclose the concept of at least one parameter that “specifically influences” biometric data. For example, *Osten* describes

using biometric data that is “non-specific,” and *Hoffberg* describes obtaining dynamic influencing data that are stored separately from static data (col. 34, line 29). In both the non-specific data of *Osten*, and the dynamic influencing biometric data of *Hoffberg*, there is no “specific” correlation of such data with certain biometric data that is taken into account to verify an individual. The shortcomings of *Osten* are described in the appeal brief filed on July 19, 2004, and the shortcomings of *Hoffberg* are described in the last reply dated October 14, 2005 to the last office action.

The fact that the at least one parameter of the rejected claims is one that specifically influences sensory detection of certain biometric data is a critical feature of the pending claims that is neither addressed in the action, nor particularly disclosed in either *Osten* and *Hoffberg*. Therefore, the proposed combination of *Osten* and *Hoffberg* fails to disclose every limitation required by the pending claims.

b. There is no suggestion or motivation to combine *Osten* and *Hoffberg*

It is submitted that one skilled in the art would not be motivated to devise the method, chip card or system according to the rejected claims in view of the combined teachings of *Osten* and *Hoffberg*. As indicated above in the preceding section, *Osten* and *Hoffberg* fail to collectively teach all of the claimed limitations. Even if combined, it is asserted that *Osten* and *Hoffberg* do not suggest to one skilled in the art the feature of verifying biometric data by taking into account at least one parameter that “specifically” influences sensory detection of biometric data.

One skilled in the art would not be motivated by *Osten* to obtain parameters that specifically influence sensory detection of biometric data used to authenticate a proprietor of such information. Instead, *Osten* teaches evaluating detected biometric data only when it is made certain that the proprietor of such biometric data is alive. Of course, the evaluation used to assure that the proprietor is alive is based on “non-specific” biometric data, and there is no hint in *Osten* of ever storing biometric

parameters and taking the same into account to specifically verify the detected biometric data.

Hoffberg, on the other hand, measures dynamically influencing data to determine moods of the proprietor of such data which in turn is used to assist in processing data to make decisions of the user's preferences. Such data is stored "separately" from static influences so that the resultant of the dynamically influencing data is based on moods or varying factors (col. 34, lines 18-32).

It is clear that since the dynamic data, which is combined to determine a mood, and the static data of *Hoffberg* are stored separately and distinctly from one another, one skilled in the art would not be motivated by such teaching to arrive at using a parameter based on a personal property that specifically influences sensory detection of biometric data and takes the same into account during a verification of the biometric data, as recited in the rejected claims.

It will be pointed out that *Hoffberg* does not suggest taking the dynamically influencing data as a resultant for nothing more than figuring out the mood of a user.

There is simply no connection in *Hoffberg*, especially in passage col. 34, lines 18-33, which is identified by the examiner in the outstanding action, of the critical features of the rejected claims, as described above. Moreover, one skilled in the art would not be motivated by the mere collection of factors known to contribute to the measurement of a mood as constituting the requirement of obtaining a specific parameter that may be used to verify certain biometric data.

It is submitted that one skilled in the art would not find the suggestion of collecting mood data of *Hoffberg* sufficient motivation to use the same in the system of *Osten* to verify certain biometric data. This is because the system of *Osten* already checks for many of the same factors identified by *Hoffberg*, such as heart rate and temperature (col. 2, line 66 through col. 3, line 13) in determining the viability of a

user. The fact that *Hoffberg* collects such aggregate dynamically influencing data and stores it separately from static data would not motivate a skilled artisan to modify the system of *Osten* since nothing would be gained over the system of *Osten*.

In view of these observations, it is submitted that if one skilled in the art were to combine *Osten* and *Hoffberg* in the prescribed manner in the action, and definitely one skilled in the art would not arrive at the invention recited in the rejected claims of the pending application since these patents fail to suggest all of the limitations of the rejected claims, and one skilled in the art would not be motivated by these patents to devise the method, chip card and system of the rejected claims.

c. There is no reasonable expectation of success

Since it has been shown in the above sections, that *Osten* and *Hoffberg*, whether considered individually or collectively, lack sufficient evidence that would motivate one skilled in the art the features of determining and storing at least one parameter on an individual property that specifically influences sensory detection of biometric data which is taken into account in a verification stage, it follows that the proposed modification of these references would not be successful at devising the method, chip card and system of the rejected claims.

d. Summary

Accordingly in view of the aforementioned reasons on the shortcomings of the combination of *Osten* and *Hoffberg*, the proposed combination of *Osten* and *Hoffberg* fails to establish *prima facie* obviousness of the rejected claims. Withdrawal of this rejection is respectfully requested.

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3. Conclusion

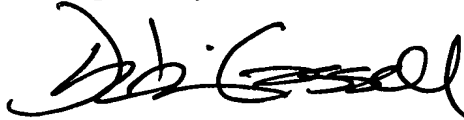
As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the pending application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: (703) 683-0500
Facsimile: (703) 683-1080

Date: March 24, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written over a horizontal line.

JUSTIN J. CASSELL
Attorney for Applicants
Registration No. 46,205